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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,859	02/28/2002	Benjamin J. Parker	1797 (15815)	2991

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EXAMINER

GEREZGIHER, YEMANE M

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

87

Office Action Summary

Application No.

10/085,859

Applicant(s)

PARKER ET AL.

Examiner

Yemane M. Gerezgiher

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-11 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's response received on 06/02/2005 has been entered. Claims 1-11 and 13 remain pending in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 reads as:

A software product for... the **software product comprising:**

software configured to:

obtain...

...

a storage system that stores said **software product**.

As it reads, it does not make any technological sense for a software product to comprise software and a storage system that stores itself (software product). Thus, it is unclear what the applicant encompasses to cover by the claim. However, for examination purpose, the examiner presume that the claim is directed to a software/program that is tangibly

embodied in a computer readable storage/medium and when executed by a computer system to perform the functional limitation as recited in the body of the claim.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 13 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In Claim 13, the inventive entity recite, *A software product configured to transmit information...establish a data call between resident computers ...* (see Claim 13 Page 21 Claim Lines 1-6).

This claim is directed to a non-statutory subject matter (**a software per-se**), which is not tangibly embodied on a computer readable medium so is to be executable. **In order to cure the deficiency of the claim 13 as presented, the inventive entity further recite, “a storage system that stores said software product.”** (See Claim 13 Page 21 Claim Lines 34). However, the Examiner could not find any evidence in the specification describing the claimed storage system storing the software product, which lack antecedent basis in the specification. Furthermore, the storage system as recited

in the claim is not explicitly described/mentioned in the specification of this application to show whether it is a computer readable medium storing the software or simply a storage system that may not be a computer readable medium/storage.

For examination purpose, the examiner will continue to read the limitation ("storage system storing the software product") to mean computer readable medium/storage having therein a program/software product and when executed by a computer device to perform the limitations disclosed in the claim. Thus, Claim 13 is rejected as been directed to a non-statutory subject matter.

Appropriate correction may be done in accordance with the following two sections of the MPEP:

- a. **MPEP 608.01 (o) [R-2]** (Basis for Claim Terminology in Description) and
- b. **MPEP 2163.07 [R-1]** (Amendments to Application Which Are Supported in the Original Description), in order to get the claims terms in to the specification.

MPEP 2163.07, section **I. (REPHRASING)** reads, "Mere rephrasing of a passage does not constitute new matter. Accordingly, a rewording of a passage where the same meaning remains intact is permissible. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973). The mere

inclusion of a dictionary or art recognized definitions known at the time of filling an application would not be considered new matter."

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 6-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ludwig et al (U.S. Patent Number 5,978,835) hereinafter referred to as Ludwig in view Dowling (U.S. Patent Number 6,714,536).

As per claim 1: maintaining a central server coupled to said internetwork and containing a database of IP addresses of registered computers; running first and second call clients in said first and second computers, respectively, for establishing a data call between said computer apparatus and said remote computer in accordance with resolved IP addresses obtained from a name server (such as DNS) or a server (such as DHCP, ARP or RARP) that allocates IP addresses from its database of IP addresses, said data call comprising live video exchange from at least one video camera coupled to one of said first and

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second computers and comprising a network session between said first and second call clients; [see Column 18 Lines 62-65, Column 19 Lines 61-67, Fig. 23, Fig. 31B, Column 21 Lines 6-20 and Lines 48-65 : Ludwig disclosed a central real-time multimedia server allowing audio/video communication in an IP network and where the clients initiating and establishing real-time communication sessions such as live video session having therein associated cameras with the respective communication device. Ludwig disclosed a name server resolving IP addresses when establishing a data call in the communication network] establishing a voice telephone call between first and second users of said first and second computers, respectively, at least one of said first and second users being seen in said live video exchange; [see Figs. 2A-2B, Column 19 Lines 11-19, Column 24 Lines 22-29 and Lines 48-50: Ludwig disclosed a live video telephony where there are plurality of participants seen in the live video telephony or conference] said first user initiating a first image viewer subclient under control of said first call client; [see Column 19 Lines 11-19: Ludwig taught a client electing and initiating a collaborated session and selecting desired participants]said first image viewer subclient loading and displaying still image data specified by said first user on said first computer; [see Figs. 2A-2B: Ludwig disclosed a client displaying still images on a window display separate from the real-time video telephony] said first image viewer subclient transmitting said still image data to said second computer using said network session; [see Column 19 Lines 43-45: Ludwig disclosed

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sending the still image view to other participants invoking a snapshot sharing module at each participant's display] said second call client in said second computer receiving said still image data, running a second image viewer subclient, and loading said still image data into said second image viewer subclient; [see Column 21 Lines 47-65 and Column 26 Lines 30-40: Ludwig disclosed sharing the still image among all the intended participants window display] and said second image viewer subclient displaying said still image data on said second computer; wherein said live video exchange is maintained simultaneously with display of said still image data by said image viewer subclients [See Figs. 2A-2B, Column 24 Lines 22-30, Column 26 Lines 30-40 and Lines 58-67].

Ludwig substantially disclosed the invention as claimed. However, Ludwig failed to teach **establishing a voice telephone call via a public telephone network as amended in claim 1.**

However, as evidenced by the teachings of Dowling, establishing a telephone call via a public telephone network was known in the art at the time of the invention. See Abstract, Column 6 Lines 1-34, Column 8 Lines 51-62, Column 32 Lines 23-31, and Column 32 Lines 39-64. Thus, it is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Dowling related to dialing a telephone number via a PSTN and have modified the teachings of

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Ludwig related to sharing multimedia (video and image) conference in a face-to-face collaboration in a packet switched network, because such a modification would enhance the invention of Ludwig to “automatically set Internet session in response to the dialed number... in order to share information over an inventive link which enables full service data conferencing to become automatically associated with a PSTN telephone call”. See Dowling Column 6 Lines 1-13.

As per claim 2: wherein said network session is comprised of direct transmissions between said first and second computers as source and destination of said transmissions, respectively. [See Fig. 23: Ludwig taught the caller (first computer) requesting an address of the target (second computer by communicating with a DNS, the DNS returning the target (second computer address and then after the first computer communicating with the second computer accordingly].

As per claim 3: said network session is comprised of a first network session between said first computer and said central server and a second network session between said second computer and said central server, whereby said central server relays said live video exchange and said still image data. [See Fig. 31B and Column 21 Lines 6-20].

As per claim 4: wherein said still image data is comprised of an array of pictures, and wherein said pictures are displayed in succession by said first

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and second image viewer subclients substantially simultaneously. [See Figs. 2A-2B, Column 24 Lines 22-30 and Column 26 Lines 30-40 and Lines 58-67].

As per claim 6: wherein progression through said array is controlled in response to manual control signals generated by said first user or said second user. [Figs. 36-37: in reference to shared window 210, Ludwig disclosed manual control icons to navigate through the image in a backward and/or forward direction].

As per claim 7: wherein said transmitted still image data is compressed data and wherein said second image viewer subclient decompresses said still image data prior to displaying. [See Figs. 31B-31C, Column 32 Lines 52-60]

As per claim 8, Ludwig failed to teach, transmitting said target telephone number to said central server for determining one of said IP addresses.

However, as evidenced by the teachings of Dowling, *transmitting said target telephone number to said central server for determining one of said IP addresses* was known in the art at the time the invention was made. See Dowling Abstract, Column 32 Lines 23-64. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Dowling related to capturing a dialed telephone number to identify an IP address associated with a target device to establish a packet based session and have modified the teachings of Ludwig related to sharing

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multimedia (video and image) conferencing facilitating communication by providing a hybrid communication networks allowing users to converse over the PSTN link and exchange multimedia data (such as video and still images) over the Internet. See Column 20 Lines 1-4, Column 6 Lines 1-13 and Column 34 Lines 45-51.

As per claims 9 and 13: a call client for transmitting information identifying said remote computer to a central server maintaining a database of IP addresses of registered computers, and for establishing a data call between said computer apparatus and said remote computer in accordance with resolved IP addresses obtained from a name server (such as DNS) or a server (such as DHCP, ARP or RARP) that allocates IP addresses from its database of IP addresses, said data call comprising live video exchange from at least one video camera coupled to one of said computer apparatus or said remote computer, and said data call comprising a network session; [see Column 18 Lines 62-65, Column 19 Lines 61-67, Fig. 23, Fig. 31B, Column 21 Lines 6-20 and Lines 48-65 : Ludwig disclosed a central real-time multimedia server allowing audio/video communication in an IP network and where the clients initiating and establishing real-time communication sessions such as live video session having therein associated cameras with the respective communication device. Ludwig disclosed a name server resolving IP addresses when establishing a data call in the communication network] and an image viewer subclient under control of said call client for loading and displaying still image

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data specified on said first computer and for transmitting said still image data to said remote computer using said network session; [see Column 19 Lines 43-45, Column 9 Lines 19-28, Column 26 Lines 30-40, Column 26 Lines 58-67 and Figs. 2A-2B] wherein said live video exchange is maintained simultaneously with display of said still image data by said image viewer subclient. [See Figs. 2A-2B, Column 24 Lines 22-30].

Ludwig substantially disclosed the invention as claimed. However, Ludwig failed to teach a **“telephone interface for capturing a target telephone number dialed on a telephone connected to said telephone interface...the captured telephone number identifying said remote computer to a central server maintaining a database of IP addresses”**.

However, Dowling taught dialing a telephone number via a PSTN (See Abstract, Column 6 Lines 1-34, Column 8 Lines 51-62, Column 32 Lines 23-31, and Column 32 Lines 39-64), capturing the dialed telephone number and identifying an IP address associated with the dialed telephone number to initiate/establish a packet based session between communication devices, and communicating information data using the packet based network (Internet) while also maintaining a voice communication through a PSTN (Column 8 Lines 36-50, Column 9 Lines 1-6, Column 19 Lines 41-44, **Column 19 Line 65-Column 20 Line 4, Column 20 Lines 27-28 and Column 32 Lines 23-64**).

Thus, it is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Dowling related to dialing a telephone number via a PSTN, to capture the dialed number and use the captured telephone number in establishing a TCP/IP session and have modified the teachings of Ludwig related to sharing multimedia (video and image) conference in a face-to-face collaboration in a packet switched network, facilitating communication by providing a hybrid communication networks allowing users to converse over the PSTN link and exchange multimedia data (such as video and still images) over the Internet. See Column 20 Lines 1-4, Column 6 Lines 1-13 and Column 34 Lines 45-51.

As per claims 10 and 11: wherein said image viewer subclient comprises a user interface responsive to a user for specifying said still image data as an array of pictures and wherein said user interface is further responsive to said user for specifying a progression for successively displaying said pictures. [See Figs. 2A-2B, 36-37 and Column 19 Lines 11-19].

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole

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would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ludwig et al (U.S. Patent Number 5,978,835) in view Dowling (U.S. Patent Number 6,714,536) and further in view of Anderson (U.S. Patent Number 6,847,388).

The already combined teachings of Ludwig and Dowling as applied to claim 1 above, substantially disclosed the invention as claimed. However, already combined teachings of Ludwig and Dowling were silent about controlling the array of still images in response to a timing sequence specified by the user. However, this feature as evidenced by the teachings of Anderson was known in the art at the time the invention was made. Anderson disclosed a method of controlling images displayed on a user interface and further disclosed a user setting a specified timing sequence in displaying the still images on the display. See Abstract and Column 13 Lines 18-21. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Anderson related to user defined timing rate of sequence and have modified the already combined teachings of Ludwig and Dowling related to concurrently sharing still image or snapshots alongside ongoing video conference or video telephony in order to "provide more efficient ways to quickly navigate through a series of images" See Column 2 Lines 31-32.

Response to Arguments

10. Applicant's arguments with respect to claims 1, 9 and claim 13 have been considered but are moot in view of the new ground(s) of rejection.

However, examiner likes to address a few arguments made by the applicant as follows:

Applicant's argument in regards to the **35 USC § 101** rejection applied to claim 13 (applicant's remark on page 7 3rd paragraph) by referencing to a "flowchart entitled Examination Procedures For Computer-Related Inventions, involving Box 6, Box 8, Box 12 and Box 14" trying to produce evidence that claim 13 is directed to a statutory subject matter. However, the examiner respectfully disagrees with such a statement. Once again, the language "storage" or "storage system" in the claim is not disclosed in the specification of this application explicitly showing whether the "storage" is a computer readable storage or medium storing therein the software product. Let alone a computer readable storage, there is no any statement in the specification to describe or recite the "storage system". As it currently read in the claim, "a storage system storing the software product" could mean any storage such as paper and/or any type of storage that may satisfy a reasonably broad definition of "storage". Therefore, the rejection is maintained, because the claim is directed to a "software product" per se, which is not tangibly embodied on a computer readable medium so to be executable. Additionally, the storage in the claim is

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not clearly defined whether it is a computer readable storage or not.

Conclusion


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yemane M. Gerezgiher whose telephone number is (571) 272-3927. The examiner can normally be reached on 9:00 AM - 6:00 PM Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached at (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YMG

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